Attorney's Docket No.: 05110-003004 3/14/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant : David J. Boothby
Serial No. : 09/240,563
Filed : January 29, 1999
Title : SYNCHRONIZATION OF DISPARATE DATABASES

Art Unit : 2171
Examiner : C. Rones

BOX AF
Commissioner for Patents
Washington, D.C. 20231

BRIEF ON APPEAL

(1) Real Party in Interest

The real party in interest is Pumatech, Inc., San Jose, California.

(2) Related Appeals and Interferences

There are no related appeals or interferences.

(3) Status of Claims

Claims 22-27 are the only claims pending.

(4) Status of Amendments

There are no amendments.

(5) Summary of Invention

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The invention is directed to synchronizing the data records of a plurality of disparate databases. Data records from one or more of the databases are compared to corresponding data records of a status file that reflects the contents of data records existing at the time of a prior

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synchronization, to determine whether data records of the database have changed or been deleted since the prior synchronization or whether there are new data records since the earlier synchronization. The databases and the status file are updated based on the outcome of this comparison. The invention is particularly useful for databases that have data records without unique identification codes.

(6) Issues

Whether a double patenting rejection is warranted when, under the new statute in effect since implementation of the GATT, the application will expire on the same day as the issued patent?

(7) Grouping of Claims

The claims stand or fall together on the double patenting issue.

(8) Argument

Any patent issuing on this application would necessarily, under the statute, expire before the expiration of U.S. Patent No. 5,684,990. The patent expires at the later of seventeen years from the issue date, or twenty years from the date of filing, whichever is later.

A patent issuing on the current application would expire twenty years from its earliest filing date, as the provision permitting the term to be computed as seventeen years from issuance does not apply to this application, as it was filed in 1999.

Accordingly, it is unnecessary and inappropriate to require a terminal disclaimer.

The judicially-created doctrine under which such terminal disclaimers were created was born at a time when all patents expired seventeen years from issue, and thus necessarily a patent issuing on an application still pending would expire later than a patent already issued. That remedy has no bearing today, except in the rare instance (not present here) of an application still pending that was filed before the GATT transition date.

The examiner cites In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA, 1982) as controlling on the PTO's authority to have promulgated regulations requiring that terminal disclaimers provide for a patent to be unenforceable should its ownership not be identical to that

of the prior patent on which the double patenting rejection was based. But Van Ornum, as it was decided by the Court of Customs and Patent Appeals, before the creation of the Federal Circuit, is not binding precedent on the Federal Circuit, And the Federal Circuit, while it has cited Van Ornum on other grounds, has not directly addressed the issue of whether the PTO had the authority to promulgate a rule requiring that a terminal disclaimer provide for unenforceability in the event of loss of common ownership. This issue needs to be addressed by the Federal Circuit, particularly in a case like the present one in which the original function of a terminal disclaimer--namely, assuring that a second patent for a similar invention would not be in force after expiration of the first to issue patent--is moot because of new laws defining the terms of patents.

The brief fee of $160 is enclosed. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 2/19/02

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Appendix of Claims

22. A data processing method for synchronizing the data records of a plurality of disparate databases, the method comprising the steps of:

providing a status file containing data records reflecting the contents of data records existing in at least one of the disparate databases at the time of a prior synchronization;

comparing data records from at least one of a first and a second of the plurality of databases to corresponding data records of the status file to determine whether data records of the database have changed or been deleted since the prior synchronization or whether there are new data records since the earlier synchronization;

updating the first and second databases based on the outcome of the comparing step; and

updating the status file so that its data records reflect the contents of the data records after they have been updated,

wherein the data records of the first and the second databases are without unique identification codes.

23. A data processing method for synchronizing the data records of a plurality of disparate databases, the method comprising the steps of:

providing a status file containing data records reflecting the contents of data records existing in at least one of the disparate databases at the time of a prior synchronization;

comparing data records from at least one of a first and a second of the plurality of databases to corresponding data records of the status file to determine whether data records of the database have changed or been deleted since the prior synchronization or whether there are new data records since the earlier synchronization;

updating the first and second databases based on the outcome of the comparing step; and

updating the status file so that its data records reflect the contents of the data records after they have been updated,

wherein at least the data records of the first database are identified by unique identification codes.

24. The method of claim 22 or 23 wherein the correspondence between data records of the first and second databases is achieved by comparing key fields of the databases.

25. The method of claim 23 wherein data records of the status file are identified by the unique identification code of the first database.

26. The method of claim 22, 23, or 25 wherein the comparing step further comprises deciding whether to delete a data record from the first database based on the comparing step having determined that the corresponding record of the second database has been deleted since the earlier synchronization.

27. The method of claim 24 wherein the comparing step further comprises deciding whether to delete a data record from the first database based on the comparing step having determined that the corresponding record of the second database has been deleted since the earlier synchronization.